



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,174	08/21/2001	Alain A. Meiland	006450-369	6436

7590 11/27/2002
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
Post Office Box 1404
Alexandria, VA 22313-1404

EXAMINER

LOCKER, HOWARD J

ART UNIT	PAPER NUMBER
----------	--------------

1661

DATE MAILED: 11/27/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

1. It would appear that the claimed rose cultivar 'Meivaleir' is described in Breeder's Right application number FR PBR 0163545, which was filed on March 20, 1997 and published on April 10, 1997 (more than one year prior to the filing date of the instant application), and which matured into Grant/Reg. Number 11226 on December 21, 1998, which was published on December 10, 1999 (more than one year prior to the filing date of the instant application). The denomination was published on April 10, 1997 (more than one year prior to the filing date of the instant application).

The claimed rose cultivar 'Meivaleir' is described in Breeder's right application number QZ PBR 980546, which was filed on April 08, 1998 and published on June 15, 1998 (more than one year prior to the filing date of the instant application), and which matured into Grant/Reg. Number 4990 on October 04, 1999, which was published on December 15, 1999 (more than one year prior to the filing date of the instant application). The denomination was accepted on October 04, 1999 (more than one year prior to the filing date of the instant application).

Each of the published applications, accepted/published denominations and published grants constitute a "printed publication" under 35 U.S.C. 102 because they are accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226; 210 USPQ 790, 794 (CCPA 1981). See also MPEP section 2128. For example, UPOV publishes the application number, grant number, date of publication, species of plant, and variety denomination for PBR certificates, and copies of the grant and application are obtainable through the Plant Variety Rights Journal. Plant varieties are also entered in the Register of Community Plant Variety Rights and Register of Applications for Community Plant Variety rights, both of which are open to the public. Thus, information regarding the claimed cultivar, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ 2d 1618, 1620, (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokora was on public use or sale in the United States but, rather, whether Siokora seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokora cultivar disclosed in the cited publications.").

While each of the publications cited above discloses the claimed plant variety, a question remains as to whether these references are enabling. If the plant was publicly available, then the published application, accepted/published denomination, or published grant, combined with the knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. The ability of the Office to determine whether the claimed plant was publicly available is limited. Electronic and paper search within the Office has not revealed any evidence that the claimed plant was on sale anywhere in the world.

However, the claimed plant may have been sold at the wholesale level, sold under a different name, or even distributed to interested parties (i.e. the public) free of charge. Since the inventor and the assignee (if applicable) of the instant application are in a better position to know when, if ever, the claimed plant was made publicly available, the Examiner is requiring this information per the attached Requirement for Information Under 37 CFR 1.105.

A requirement for information under 37 CFR 1.105 is attached. This requirement is subject to the provisions of 37 CFR 1.134, 1.135 and 1.136 and if unaccompanied by an Office action on the merits has a shortened statutory period of 2 months from the mailing date of this communication. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a). **However, as the requirement for information in this application is being mailed with an Office action on the merits, the time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is three months.**

2. The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention."

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

"The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted."

The disclosure is objected to under 37 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se, and which distinguish same over related or similar known cultivars and antecedents.

More specifically:

A. During a search of UPOV-ROM, the following "hit" on a rose cultivar named 'Meivaleir' was found: (1) FR PBR 0163545.

While this earlier filed foreign document would appear to be drawn to the same plant given the limited information available on UPOV-ROM (such as assignee) it cannot conclusively or positively be determined that such is the case.

Applicant must substantively address and obviate this issue responsive to this Office action (so as to provide as complete a description of

the plant as is reasonably possible) by one of the two avenues mentioned below:

(1) If the above is indeed drawn to the same plant as is presently described and illustrated (i.e. the instant plant), such needs to be positively and clearly acknowledged in applicant's comments responsive to this Office action. In the alternative, applicant could file a substitute declaration incorporating this earlier prior foreign filing so as to clarify the issue should such be found to be the case, even though foreign priority is not being claimed (and in this instance cannot be claimed);

(2) If the above earlier filed referenced foreign document refers to a different floribunda rose plant, it would be necessary for applicant to take corrective action relative to the cultivar name of the plant presently described and illustrated (i.e. the "instant" plant) such as by correcting same, as reuse of the cultivar name 'Meivaleir' would then be inadmissible under at least Article 48, Article 50, and Article 51 of the *INTERNATIONAL CODE OF NOMENCLATURE FOR CULTIVATED PLANTS-1980*.

As plant names are associated with and used to identify particular plants and are therefore descriptive, for a United States Plant Patent to properly issue, the cultivar name set forth in the specification must be proper.

B. Parentage of the instant plant is not set forth clearly in the specification, as reference to the seed parent appears as "The female parent...of the 'Meipalsar' variety. It is not clear whether 'Meipalsar' is the seed parent or if this recitation appears in the specification wholly in error, and in reference to another plant entirely, not to the instant cultivar 'Meivaleir' as described and illustrated. Later on page 1, the specification states that 'Meipalsar' is a parental cultivar. Correction to a single and accurate recitation relative to the parentage of the instant plant is necessary.

C. That the rose cultivar 'Circus' is the subject of United States Plant Patent Number 2074 as stated in applicant's specification does not appear to be the case. United States Plant Patent Number 2074 states that the cultivar described therein is a bud sport of 'Circus', which is the subject of United States Plant Patent Number 1382, distinguished from same by its climbing habit. From the records available to the examiner, United States Plant Patent Number 2074 would appear to be properly named 'Climbing Circus'.
Correction and/or clarification is necessary.

D. The instant plant should be distinguished on the record from its stated antecedents. Such need not be in any great detail.

E. Leaflet shape should be accounted for in the specification, at least in general terms. Presently, only the base and tip of same are referenced therein.

F. From the submitted illustration, the juvenile foliage and peduncle would appear to bear substantial anthocyanin coloration. Such, if accurate, should be accounted for as appropriate in the specification.

G. Given the stated market class as a climber, the statement in the specification that the plant bears one or two flowers per stem is problematic as there is no indication of relative number of branches per main stem for the plant when grown to the size set forth in the specification. Some mention should be made relative thereto, or to the relative breaking propensity of the plant, or to the relative floriferousness of the cultivar per se, and if the plant flowers on new or old wood (or both). In the alternative, applicant could submit an additional photographic illustration to convey this information.

H. More meaningful information should be imported into the specification relative to characteristic and observed lastingness of the individual blooms on the plant, such as by setting for an observed range in days for the bloom on the plant as the current recitation "long on the plant" states little in positive or meaningful terms. If lastingness as a cut flower has been systematically observed, such should likewise be incorporated into the specification in the interest of providing as complete a botanical description of the plant as is reasonably possible.

I. Petal margin characteristics and petal shape should be more meaningfully accounted for in the specification in the interest of providing as complete a botanical description of the plant as is reasonably possible.

J. Information should be imported into the specification as to whether the petals persist or drop with age.

K. Some botanical description, at least of a general nature, should be imported into the specification relative to reproductive organs (i.e. presence per se, relative quantity (if present), coloration, etc.).

L. If pollen is characteristically produced, such should be accounted for in the specification with reference both to quantity and coloration.

M. If more meaningful information is now available relative to observed and characteristic disease resistance of the instant plant, such should be incorporated into the specification, particularly as the instant plant is stated to be particularly well suited for growing as ornamentation in parks and gardens, this itself connoting substantial disease resistance being present.

N. If length of the flowering stem (assumedly laterals) has been systematically observed, information relative to such should be incorporated into the specification in the interest of providing as complete a botanical description of the plant as is reasonably possible.

O. Information relative to characteristic and observed height of the plant needs to be reviewed for accuracy and information relative to observed spread/width of the cultivar at the observed location of culture should be imported into the specification. Currently the height at one year of age is set forth, and it is assumed that this reflects the plant at two years of age. It is unclear, given the stated market class of the plant, that such properly reflects plant height or main cane length. Correction and/or clarification is necessary.

The above listing may not be comprehensive. Applicant should carefully review the disclosure and import into same any additional or corrected information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is being sought.

3. The claim is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant, for the reasons set forth in paragraph 2 above.

4. Applicant is advised of the changes to 37 CFR 1.84 which took effect November 29, 2000 and apply to any applications (and to new drawings filed in previously existing applications) filed thereafter. In particular, 37 CFR 1.84(e) now states, in part:

Photographs must be developed on paper meeting the sheet size requirements of paragraph (f) of this section and margin requirements of paragraph (g) of this section.

The USPTO no longer accepts photographs mounted on Bristol board, paper or other material. Further information on the new rules is available on the USPTO web site at www.uspto.gov.

The USPTO has delayed enforcement of the above changes until October 01, 2001. Drawings in compliance with old rules will be accepted through September 30, 2001. Complete details can be found in the May 22, 2001, Official Gazette (1246 OG 106-107) on the internet at:
<http://www.uspto.gov/web/offices/com/sol/og/2001/week21/patvavr.htm>

5. Applicant is advised of the new procedures for amending the specification and claim under 37 CFR 1.121. The new procedures are optional until February 28, 2001 and **mandatory** beginning March 01, 2001. Information on the new procedures is available on the internet at <http://www.uspto.gov/web/offices/dcom/olia/pbg/index.html>.

Serial No. 09/933174
Art Unit 1661

-11-

6. Any inquiry concerning this communication from the examiner should be directed to Examiner Howard J. Locker whose telephone number is 703-308-2924, and whose normal work hours are Monday through Thursday, from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Bruce Campell, can be reached at 703-308-4205.


Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

TELECOPY/FACSIMILE TRANSMISSION

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to this Group via the PTO Fax Center in Crystal Mall 1 (CM 1). The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM 1 Fax Center number is 703-308-4556 or 703-305-3592.

Howard J. Locker/hjl

November 20, 2002


HOWARD J. LOCKER
EXAMINER
GROUP ART UNIT 1661

REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.105

Applicant and the assignee (if applicable) of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined reasonably necessary to the examination of this application.

The information is required to determine when, if ever, the claimed plant variety, 'Meivaleir', was publicly available prior to the filing date of the instant application.

In response to this requirement, please provide any information available regarding the sale or other public distribution of the claimed plant variety anywhere in the world, including the date(s) of any sale or other public distribution. Also, please provide copies of the above referenced published applications, published denominations, and published grants. The Office does not maintain a collection of Breeder's Rights documents and they are not readily obtainable electronically. It is reasonable to expect that Applicant or assignee (if applicable) can readily obtain the requested documents and information.

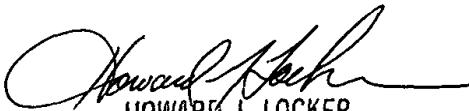
The fee and certification requirement of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

Serial No. 09/933174
Art Unit 1661

-13-

Applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or not readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is three months.


HOWARD J. LOCKER
EXAMINER
GROUP ART UNIT 1661